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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,462	04/24/2001	Yi Li	401184	1939

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EXAMINER

SHARON, AYAL I

ART UNIT PAPER NUMBER

2123

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/840,462	LI ET AL.	
	Examiner	Art Unit	
	Ayal I Sharon	2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. Claims 1-5 of U.S. Application 09/840,462 filed on 4/24/2001 are presented for examination.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
3. In p.4 of the specification, the Applicants incorporate by reference the following article:

Li, Y., "Advanced Computing Technology for Integrated Design of Textiles and Apparel." Ergonomics of Protective Clothing, Proc. of NOKOBETEF 6 and 1st European Conference on Protective Clothing. Stockholm, Sweden; May 7-10, 2000.

Examiner was unable to locate a copy of the reference. Applicants are requested to provide a copy of this reference.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending U.S. Application No. 09/840,444. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application pertains to (e.g., as in claim 1), "thermal characteristics", while the claims in U.S. Application No. 09/840,444 pertain to "biomechanical and structural characteristics". Examiner finds that "thermal" characteristics are a subset of "biomechanical" characteristics.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. More specifically, enablement is lacking for “computational simulation of the information”, as recited in Claim 1. All dependent claims inherit this defect.
8. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, written description is lacking for “computational simulation of the information”, as recited in Claim 1. All dependent claims inherit this defect.
9. The specification regarding the claimed invention is deficient in the areas cited above. Accordingly, the examiner has made prior art rejections based on the limited scope of information contained in the specification for supporting the claims. The rejections are complete and specifically applied against the claims based on this limited disclosure.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. The prior art used for these rejections is as follows:

12. De Monte et al., U.S. Patent Application Publication 2003/0156619 A1

(Henceforth referred to as "**De Monte**").

13. The claim rejections are hereby summarized for Applicant's convenience. The detailed rejections follow.

14. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by De Monte.

15. In regards to Claim 1, De Monte teaches the following limitations:

1. A method of creating thermal functional designs of textiles and clothing using computer and visual display monitor controlled by the computer, the method comprising

supplying the computer with information from databases relating to thermal physiological characteristics of a human body
(See De Monte, especially: p.3, paragraphs 45-53)

and thermal characteristics of chosen textile materials
(See De Monte, especially: pp.3-4, paragraphs 54-64)

for computational simulation of the information, and
(See De Monte, especially: pp.3-4, paragraphs 61-64)

creating visual images for the monitor showing modules
of structural functional designs.
**(See De Monte, especially: p.3, paragraph 57, in particular
“... said mathematical model supplies as output data the
thermal map on the surface of the foot...”)**

16. In regards to Claim 2, De Monte teaches the following limitations:

2. The method according to claim 1, in which the
database of the human body comprises human model data
for specific body functions, including size and shape.
**(See De Monte, especially: p.3, paragraphs 45-53.
Example provided of the human foot.)**

17. In regards to Claim 3, De Monte teaches the following limitations:

3. The method according claim 1, in which the
database of the garments comprises clothing patterns
data and product specification data.
**(See De Monte, especially: pp.3-4, paragraphs 54-64.
Example provided – paragraph 54 – of “length, width, thickness
and thermal properties”)**

18. In regards to Claim 4, De Monte teaches the following limitations:

4. The method according claim 1, in which the
database of the human body comprises thermal property
data, including thermo-physiological and thermal
comfort data of the human body.
**(See De Monte, especially: p.3, paragraphs 47.
“... we obtain values of temperature and surface skin humidity
which define the parameters corresponding to a condition of
thermo-physiological comfort.”)**

19. In regards to Claim 5, De Monte teaches the following limitations:

5. The method according to claim 1, in which the
database textile materials comprises thermal
property data, including fibres, yarns,

fabrics and garments.

(See De Monte, especially: p.4, paragraphs 64-70)

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ayal I. Sharon whose telephone numbers are (703) 306-0297 *[Before Oct. 25, 2004]* and (571) 272-3714 *[After Oct. 25, 2004]*. The examiner can normally be reached on Monday through Thursday, and the first Friday of a biweek, 8:30 am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached at (703) 305-9704 *[Before Oct. 25, 2004]* and (571) 272-3716 *[After Oct. 25, 2004]*.

Any response to this office action should be faxed to (703) 872-9306 or mailed to:

Director of Patents and Trademarks
Washington, DC 20231

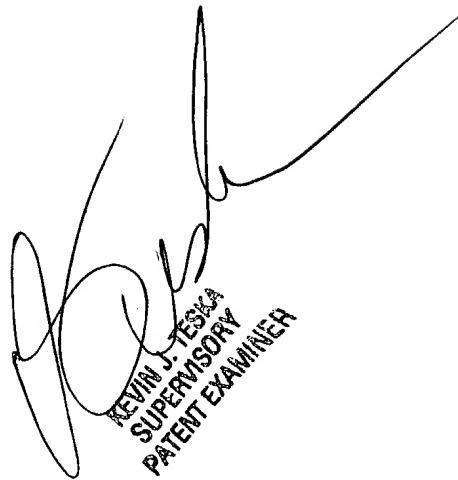
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2100 Receptionist, whose telephone number is (703) 305-3900 *[Before Oct. 25, 2004]* or (571) 272-2100 *[After Oct. 25, 2004]*.

Art Unit: 2123

Ayal I. Sharon

Art Unit 2123

September 20, 2004



KEVIN J. TESLA
SUPERVISORY
PATENT EXAMINER